

### **Remarks**

Claims 1-36 are pending. Claims 1, 10, 19, and 28 have been amended. The Examiner rejected claim 28 under 35 U.S.C. 112. The Examiner rejected claims 10, 12-14, and 18 under 35 U.S.C. 102(b) as being anticipated by Williams et al (U.S. PGPub 2001/0042230 A1). The Examiner rejected claims 1, 2, 6-9, 19, 20, and 24-27 under U.S.C. 102(e) as being anticipated by George (U.S. Patent No. 6,993,679 B2). The Examiner rejected claims 10, 11, and 13-15 under 35 U.S.C. 102(e) as being anticipated by Humlincek et al. (U.S. Patent No. 6,944,791 B2). The Examiner has rejected claims 3-5, 21-23, and 28-36 under 35 U.S.C. 103(a) as being obvious over the combination of George in view of Williams et al. The Examiner has rejected claims 16-17 under 35 U.S.C. 103(a) as being obvious over the combination of Williams et al. in view of George.

#### **1. Rejections Under 35 U.S.C. § 112**

The Examiner rejected claim 28 under 35 U.S.C. 112 as being indefinite due to insufficient antecedent basis for the limitation “the file.” Applicants have amended claim 28 to remove this limitation and request that the rejection of this claim be withdrawn.

#### **2. Independent Claims 1, 10, 19, and 28**

##### **Rejections Under 35 U.S.C. 102**

In order for an anticipation rejection under section 102 to be proper, each and every limitation found in the claims must be disclosed in the reference, either expressly or inherently. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998); *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Circ 1994). Each of the four

independent claims, as amended, requires that “the write operation is performed with counter and date information.” Paragraph [0018] of the Applicants’ Specification states, “In another embodiment, a counter and date can be stored along with the signature on each repaired sector in order to avoid multiple event logging and/or user notification for a single sector.” Additionally, this technique can be used to “track the age of the repaired (but not corrected) sector.” (Spec., [0018]) Thus, it is clear that the counter and date information play a useful role in the present invention. The Examiner has rejected independent claim 10 over Williams et al., independent claims 1 and 19 over George, and independent claim 10 again over Humlicek. However, none of Williams, George, and Humlicek teaches or discloses the limitation “the write operation is performed with **counter** and **date** information.” Indeed, the words “date” and “counter” do not appear in any of these three references. These three references do not expressly teach this limitation, nor do they inherently teach it through discussion of signatures. As such, Williams, Humlicek, and George do not anticipate any of the independent claims of the present invention because they do not teach each and every single claim limitation. Applicants request the withdrawal of the rejections of the independent claims under section 102.

### **Rejections Under 35 U.S.C. 103**

Applicants submit that a prima facie case of obviousness has not been established and that a rejection of the pending claims on obviousness grounds is improper. A prima facie case of obviousness requires a showing that all of the claim limitations of the rejected claims are taught or suggested by the prior art. Manual of Patent Examining Procedure 2143 and 2143.03. The establishment of a prima facie case of obviousness requires that *all* the claim limitations be taught or suggested by the prior art. MPEP 2143.01 (emphasis added). “All words of a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*,

424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). Here, because all of the elements of the independent claims are not taught or suggested by the prior art combination identified by the examiner (George and Williams et al.), a *prima facie* case of obviousness cannot be established and the rejection of these claims should be withdrawn.

Specifically, the Examiner has rejected independent claim 28 over the combination of George and Williams et al. As stated above, neither George nor Williams et al. teaches or suggests the limitation that “the write operation is performed with **counter** and **date** information.” The Examiner has stated that George does not teach writing invalid ECC data and that Williams et al. teaches writing invalid ECC data. (Office Action, p.8) However, neither Williams et al. nor George teaches or suggests performing a write operation with **counter** and **date** information. Specifically, the cited portion of Williams does not teach or suggest these limitations. Because the combination of Williams et al. and George does not teach or suggest all of the elements of the independent claims, specifically independent claim 28, the independent claims are not obvious over this combination. Thus, Applicants request the withdrawal of the rejections of the independent claims under section 103.

### **3. Dependent Claims 2-9, 11-18, 20-27, and 29-36**

Dependent claims 2-9, 11-18, 20-27, and 29-36 will not be discussed individually herein, as each of these claims depends, either directly or indirectly, from an otherwise allowable base claim. Applicants submit that the rejection of claims 2-9, 11-18, 20-27, and 29-36 should be withdrawn.

**Conclusion**

Applicants respectfully submit that pending claims 1-36 of the present invention are allowable. Applicants respectfully request that the rejection of these claims be withdrawn and that these claims be passed to issuance.

Respectfully submitted,



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